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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/445,065	12/01/1999	STEFAN BODENSCHATZ	BEIERSDORF-5	9425

7590

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Kurt G Briscoe  
Norrisl McLaughlin & Marcus  
220 East 42nd Street  
30th Floor  
New York, NY 10017

EXAMINER

POTHIER, DENISE M

ART UNIT

PAPER NUMBER

3764

DATE MAILED: 12/12/2001

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No. 09/445,065	Applicant(s) BODENSCHATZ ET AL.	
	Examiner Denise Pothier	Art Unit 3764	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 17 December 1999.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 01 December 1999 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☒ All   b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                             | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____  |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                    | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other:  |

**DETAILED ACTION**

***Priority***

1. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

***Information Disclosure Statement***

2. The information disclosure statement filed 12-17-99 (Paper No. 6) fails to comply with the provisions of 37 CFR 1.97, 1.98 and MPEP § 609 because the references do not include the required date. It has been placed in the application file, but the information referred to therein has not been considered as to the merits. Applicant is advised that the date of any re-submission of any item of information contained in this information disclosure statement or the submission of any missing element(s) will be the date of submission for purposes of determining compliance with the requirements based on the time of filing the statement, including all certification requirements for statements under 37 CFR 1.97(e). See MPEP § 609 ¶ C(1).

***Drawings***

3. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the support strap designed partially divided in two parts immediately after the attachment point on the shoulder cap as recited in claim 9 must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

### **Specification**

The following guidelines illustrate the preferred layout and content for patent applications. These guidelines are suggested for the applicant's use.

#### **Arrangement of the Specification**

The following order or arrangement is preferred in framing the specification and, except for the reference to the drawings, **each of the lettered items should appear in upper case, without underling or bold type, as section headings**. If no text follows the section heading, the phrase "Not Applicable" should follow the section heading:

- (a) Title of the Invention.
- (b) Cross-Reference to Related Applications.
- (c) Statement Regarding Federally Sponsored Research or Development.
- (d) Reference to a "Sequence Listing," a table, or a computer program listing appendix submitted on compact disc (see 37 CFR 1.52(e)(5)).
- (e) Background of the Invention.
  - 1. Field of the Invention.
  - 2. Description of the Related Art including information disclosed under 37 CFR 1.97 and 1.98.
- (f) Brief Summary of the Invention.
- (g) Brief Description of the Several Views of the Drawing(s).
- (h) Detailed Description of the Invention.
- (i) Claim or Claims (commencing on a separate sheet).
- (j) Abstract of the Disclosure (commencing on a separate sheet).
- (k) Drawings.
- (l) Sequence Listing, if on paper (see 37 CFR 1.821-1.825).

4. The disclosure is objected to because of the following informalities: please remove the reference to claim 1 on page 2. Appropriate correction is required.

5. The use of the trademark VELCRO® has been noted in this application. It should be capitalized wherever it appears and be accompanied by the generic terminology.

Although the use of trademarks is permissible in patent applications, the proprietary nature of the marks should be respected and every effort made to prevent their use in any manner, which might adversely affect their validity as trademarks.

### ***Claim Rejections - 35 USC § 112***

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

7. Claims 1-20 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

8. The recitation, "an anatomically shaped upper arm part which receives the upper arm" in claim 1, lines 1-2, is indefinite since the upper arm has become an integral component of the claim. This also applies to other parts of claim 1, 7-8 and 10.

9. Regarding claim 1, the phrase "cap-like" renders the claim(s) indefinite because the claim(s) include(s) elements not actually disclosed (those encompassed by "like"), thereby rendering the scope of the claim(s) unascertainable. See MPEP § 2173.05(d).

10. The phrase, "profiled recesses *can be* worked into the upper arm part" in claim 4, line 2, is indefinite since applicant fails to particularly point out whether or not the recesses are being recited. In addition it is unclear what these profiled recesses are.

Do they include the shoulder recess? What other recess is there? This also applies to claim 5.

11. The term, "a support strap" in claim 7, line 3, is indefinite since it is unclear whether this strap is different from the one recited in claim 1. As best understood and for purposes of examination, an assumption that they are the same strap will be made.

12. The phrase, "wherein the support strap is designed partially divided in two parts immediately after the attachment point on the shoulder cap" in claim 9 is indefinite. It is unclear from the drawings and the specification what this structure is. In addition, "the attachment point" and "shoulder cap" lack antecedent basis. Where the metes and bound of a claim are indefinite, it is improper to base a rejection on speculation as to the meaning of the claim. In re Steele, 305 F.2d 858, 134 USPQ 292 (CCPA 1962).

Specifically, those of ordinary skill in the art are presumed to have some knowledge of the art apart from what is expressly disclosed in the references. In re Jacoby, 309 F.2d 513, 135 USPQ 317 (CCPA 1962).

13. The recitation, "have a preferred longitudinal expansion of <35%" in claim 12, line 3 is indefinite since applicant has only recited a preference and fails to particularly point out the subject matter of the claims.

14. The remaining claims are rejected because they depend from rejected claims.

### ***Claim Rejections - 35 USC § 102***

15. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

16. Claims 1, 3-6 and 10 are rejected under 35 U.S.C. 102(b) as being anticipated by Abolina (SU 321252). Abolina discloses in its figure a bandage for the shoulder and upper arm comprising an anatomically shaped upper arm part (2) and an anatomically shaped forearm part (1), the upper part in the shape of a half-shell and having a cap recess (see around 2 in figure) for receiving the shoulder joint, the forearm part having a shape of a half shell and having an enclosure for the elbow joint (see around 4 in figure) and the upper arm part and forearm part being connected (through 4) to one another in an adjustable manner (can slide relative to each other and through strap and buckle system 4) and a support strap (includes strap ending from shoulder to forearm part) being arranged on the upper arm part and a holding strap (see 3) being arranged on the forearm part.

As for claim 3, Abolina discloses in its figure that the edges of the upper part and forearm part are thin.

As for claims 4-5 as best understood, profiled recesses are in the upper arm and forearm part and exert a strengthening action.

As for claim 6, see the figure of Abolina for the hand guide (near fingers).

As for claim 10, Abolina discloses in its figure and abstract the holding strap (3) that is capable of running from the forearm part, starting from the hand region dorsally in the lumbar area to the distal upper arm and laterally encloses the upper arm from posterior to anterior.

***Claim Rejections - 35 USC § 103***

17. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

18. Claims 1, 2 and 7-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Munoz in view of Abolina. Munoz discloses in Figures 1-4 a bandage for the shoulder and upper arm comprising an anatomically shapes upper arm part (includes 18) and an anatomically shaped forearm part (40), the upper part having cap recess (64) for receiving the shoulder joint, the forearm part having a shape of a half shell and the upper arm part and forearm part being connected (through 20,26) to one another in an adjustable manner and a support strap (58) being arranged on the upper arm part and a holding strap (see 52) being arranged on the forearm part. However, the upper arm part is not half shell and the forearm support does not include an enclosure for the elbow joint. Abolina teaches in its figure that a half shell is adequate to engage the user's upper arm during a fracture. Additionally, Abolina teaches to include an elbow enclosure on the forearm support for addition support. Thus, one having ordinary skill in the art would have known to make the shell of Munoz a half shell and still provide adequate engagement and support and to include an elbow enclosure on the forearm support for additional support.

As for claim 2, Munoz discloses in Figures 1-4 an encapsulating material (16 and 32) surrounding the upper arm part and the forearm part.



As for claims 7-8, see elements 58 and 62 in Figures 1-2 and the description in column 3, lines 47-49 of Munoz.

19. Claims 11-12 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Munoz in view of Abolina as applied to claim 1 above, and further in view of Johnson (4,550,869). Neither Munoz nor Abolina disclose the straps are made from laminated foam or laminated nonwoven fabric. Johnson teaches in Figures 1-4, in column 2, lines 64-68, column 3, lines 1-32 and 51-57 and column 4, lines 8-20 that it is known in the sling art to make straps from laminated foam in order to provide comfort and a load-bearing structure to the user. Thus, one skilled in the art would have known to make the straps of a laminated foam in order to provide comfort and a load-bearing structure to the user.

As for claims 12 and 20, see the above discussion. Johnson discusses longitudinal expansion. However, Johnson also teaches and suggests in column 3, lines 4-11 the straps are made from relatively non-elastic material in order to carry tensile loads. As such, one having ordinary skill in the art would have known to limit the longitudinal expansion to <35% and <10% under a load of about 50 N in order to carry tensile loads.

20. Claims 13-15 and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Abolina view of Ford (4,214,579). See the above discussion of Abolina. Abolina is silent regarding the material of the upper arm part and the forearm part. Ford teaches in column 4, lines 1-31 that it is known in the sling art to make an arm splint from a thermoformable, thermoplastic with low rigidity in order to shape the splint to the user's

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anatomy and to select a material that does not deform under pressure. Thus, one skilled in the art would have known to make the upper arm part and the forearm part of thermoformable, thermoplastic with low rigidity in order to shape the body supports to the user's anatomy and prevent deformation under pressure.

As for claim 15, adding a layer to the starting material is known in the art in order to provide additional rigidity and support. One possessing ordinary skill in the art would have known to include a second layer in order to provide more rigidity and support to the user.

21. Claims 16-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Abolina in view of Ford as applied to claim 13 above, and further in view of Cherubini (5,415,623). Ford does not disclose how the thermoformable is shaped. Cherubini teaches in column 1, lines 25-31 that it is known in the orthopedic art to use a negative mold to heat and shape body supports. Thus, it is conventional in the order to heat and shape a body support, such as the one taught by Ford, using a negative mold or using heated molds. The inclusion of a positive mold would further facilitate in shaping the support. As such, one skilled in the art would have also known to heat the support between a positive and negative mold in order to facilitate shaping the support.

22. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Melendez (4,759,353) and Herzberg (6,099,489) disclose the state of the art of slings.

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23. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Denise M. Pothier whose telephone number is 703.308.0993. The examiner can normally be reached on Monday-Thursday and alternate Fridays. The fax phone numbers for the organization where this application or proceeding is assigned are 703.872.9302 for regular communications and 703.872.9303 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to Everett Williams whose telephone number is 703.305.1708.



Denise Pothier  
Primary Examiner  
November 28, 2001

Attachment for PTO-948 (Rev. 03/01, or earlier)  
6/18/01

The below text replaces the pre-printed text under the heading, "Information on How to Effect Drawing Changes," on the back of the PTO-948 (Rev. 03/01, or earlier) form.

INFORMATION ON HOW TO EFFECT DRAWING CHANGES

**1. Correction of Informalities -- 37 CFR 1.85**

New corrected drawings must be filed with the changes incorporated therein. Identifying indicia, if provided, should include the title of the invention, inventor's name, and application number, or docket number (if any) if an application number has not been assigned to the application. If this information is provided, it must be placed on the front of each sheet and centered within the top margin. If corrected drawings are required in a Notice of Allowability (PTOL-37), the new drawings **MUST** be filed within the **THREE MONTH** shortened statutory period set for reply in the Notice of Allowability. Extensions of time may **NOT** be obtained under the provisions of 37 CFR 1.136(a) or (b) for filing the corrected drawings after the mailing of a Notice of Allowability. The drawings should be filed as a separate paper with a transmittal letter addressed to the Official Draftsperson.

**2. Corrections other than Informalities Noted by Draftsperson on form PTO-948.**

All changes to the drawings, other than informalities noted by the Draftsperson, **MUST** be made in the same manner as above except that, normally, a highlighted (preferably red ink) sketch of the changes to be incorporated into the new drawings **MUST** be approved by the examiner before the application will be allowed. No changes will be permitted to be made other than correction of informalities, unless the examiner has approved the proposed changes.

**Timing of Corrections**

Applicant is required to submit the drawing corrections within the time period set in the attached Office communication. See 37 CFR 1.85(a).

Failure to take corrective action within the set period will result in **ABANDONMENT** of the application.